

Remarks

The rejections are improper because the components cited in the references are simply not connected (or even in the same drawing) as asserted in the Office Action. The rejections are also improper because the Office Action has failed to assert any correspondence to limitations in each of the independent claims (*e.g.*, resistor sub-bodies electrically connected via taps), and further because the cited references do not disclose such an arrangement of sub-bodies. The following addresses these and other matters in greater detail.

The Final Office Action dated September 19, 2008 lists the following rejection: claims 1-8 and 12-15 stand rejected under 35 U.S.C. § 103(a) over Praria (U.S. Patent No. 4,505,032) in view of Piedmont *et al.* (U.S. Patent No. 4,228,418). Applicant traverses all of the rejections and, unless explicitly stated by the Applicant, does not acquiesce to any objection, rejection or averment made in the Office Action.

The Section 103 rejections are improper and should be removed because the Office Action has cited various components in the '032 reference that do not exist in the figures and are not connected as indicated in the Office Action. Specifically, cited figure 8 does not include a "resistor body 56" and the cited taps "64f, 64ff, 64fff and taps 64'f, 64'ff, 64'fff" from figure 8 are accordingly not connected to "body 56." It appears that the "resistor body 56" is listed in an earlier figure, but there is no discussion or other explanation in the cited reference or otherwise that indicates how these portions would function together. Applicant believes that the rejections are improper as is the finality of the instant Office Action, as it has failed to state the rejection in a clear manner as required. Should any rejections be maintained, Applicant requests clarification and an opportunity to respond.

The Section 103 rejections should also be removed because the cited combination of references does not teach or suggest all of the claim limitations, including those directed to a resistor network having resistor sub-bodies that are electrically connected to one another via taps connected with the resistor sub-bodies. Moreover, the rejections do not appear to attempt to assert correspondence to these limitations. The Office Action indicates that the '032 reference does not teach any resistor sub-bodies (see page 2), and attempts to show correspondence to such sub-bodies by citing to the '418 reference as

disclosing “a resistor body that includes multiple resistor sub-bodies.” However, the Office Action has not asserted any teaching or suggestion of an arrangement having sub-bodies that are electrically connected by taps, and has not asserted that the cited resistors (*e.g.*, 33, 34 of FIG. 3 in the secondary ‘418 reference) are connected by any taps.

Applicant believes that the ‘032 reference cannot disclose “the only electrical connections between the resistor sub-bodies are electrical connections via taps” as asserted at page 2 in the Office Action, because the ‘032 reference does disclose multiple sub-bodies as acknowledged in the very next line of the Office Action.

In addition to the above, the cited portions of the secondary ‘418 reference do not disclose columns having taps. Rather, it appears that the Office Action is referring to a single continuous strip (either 30, 31 or 32) in the alleged “columns,” which do not correspond to the claimed taps. In this regard, combining the connected resistors in the ‘418 reference with the ‘032 reference cannot teach the claimed arrangement having a column of taps. Moreover, and as relevant to new claim 16 discussed below, the continuous strips in the ‘418 reference couple multiple resistors, and thus are not limited to connecting at most two resistors.

In specific regard to claim 3, the Office Action’s suggestion that the conductors in the ‘418 reference can be severed to correspond to the claimed is untenable, because the indicated severing renders the resistors in the ‘418 reference inoperable. Specifically, at cited column 3:51-67, this severing effectively cuts off the respective resistors and renders them inoperable, in order to change the overall resistance. Doing so in connection with the ‘032 reference as asserted would not only render the ‘032 reference inoperable (contrary to applicable law and the M.P.E.P.), the resulting structure would not operate or correspond to the claimed invention.

In addition to the above, the Office Action has not asserted any rationale for modifying the references to include sub-bodies connected by taps as claimed. The alleged motivation at page 3 is to “provide a resistor network that can be used in the desired electrical connection,” which does not provide any motivation for connecting sub-bodies via taps. It is further unclear as to what the Examiner is referring to as “the desired electrical connection” as it appears that the only disclosure of the claimed connection is that in Applicant’s specification, which cannot be used in hindsight.

Applicant further traverses the rejection of claim 5 because the Office Action has provided no support for allegedly “inherent” subject matter. To establish inherency, the extrinsic evidence “must make clear that the missing descriptive matter *is necessarily present in the thing described in the reference*, and that it would be so recognized by persons of ordinary skill.” *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268 (Fed. Cir. 1991) (emphasis added). “Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Id.* at 1269, (quoting *In re Oelrich*, 666 F.2d 578, 581 (C.C.P.A. 1981)). In this instance, the Office Action has provided no such evidence and the rejections are therefore improper.

Applicant notes that claims 7 and 8 have been written as independent claims including the limitations of claim 1 from which they formerly depended, and respectfully submits that the alleged “intended use” in the Office Action is no longer applicable. In view of the above and because the cited references fail to disclose the claimed limitations, Applicant believes that the rejections are improper.

Applicant has added new claim 16. Applicant believes that this claim should be added at least because the finality of the Office Action is improper. Claim 16 is allowable over the cited references for the reasons stated above, and further because the cited references do not teach or suggest limitations directed to resistor sub-bodies connected via taps that are connected between at most two sub-bodies. Support for these limitations may be found, for example, in FIG. 1 and its corresponding discussion.

In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Peter Zawilski, of NXP Corporation at (408) 474-9063 (or the undersigned).

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